REMARKS

Upon entry of this amendment, independent claim 19 with dependent claims 22-24 and 26-35, independent claim 36 with dependent claims 38-43, independent claim 45 with dependent claims 46-49, and independent claim 50 with dependent claims 51 and 52 will be present in the application.

Claim 19 has been amended to include the limitations of claims 20 and 21, which have been canceled. Claim 36 has been amended to include the limitations of claim 37, which has been canceled. Applicant respectfully submit that such amendment does not introduce new matter.

Claims 19-35 were rejected under 35 U.S.C. § 103(a) as being obvious U.S. 5,969,606 (Reber et al.) in view of U.S. 5,939,974 (Heagle), the Office Action contending that "Reber et al further teach ... a method wherein providing identity data further comprises: reading with a hand-held data collector a label (tag) on the food item, the label (tag) having the identity data (fig. 7, 96, 98)". The Office Action admitted that "Reber et al do not teach a hand-held instrument that can transmit information to a computer" but contended that "Heagle et al teach information i.e. temperature measurement and other actions to a CPU (col. 7, lines 2-9), printing a label (tag) for the food item using a printer in electrical communications with the hand-held data collector". The Office Action further contended that it would have been obvious to "utilize transmission of information to a CPU, the label printing as taught by Heagle et al into the system of Reber et al because it would provide information to the main terminal as for managers to make decisions on the appropriate time to put or remove food items for sale."

The Applicant respectfully submits that the Reber reference does not disclose a "label (tag) having the identity data" as alleged by the Office Action. Reber merely discloses that "[t]he electronic tag 30 communicates signals with a tag communicating device 32 to monitor at least one condition of the food item 20." (Col. 3, lines 31-33) Accordingly, the only information that must be stored in tag 30 is at least one condition of the food item. Although it is possible that tag 30 may have information other than "condition" information stored therein, Reber does not teach or suggest that tag 30 include such other information. Boxes 96 and 98 of Figure 7 are labeled "listen for tag signal" and

"received a tag signal from a single tag", respectively. There is nothing in either of these boxes or in all of Figure 7 that teaches or suggests what the tag signal may include. Therefore, Reber does not disclose "label (tag) having the identity data".

It cannot be argued that the tag of the Reber reference inherently has identity data identifying the food item. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). To rely on the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, " . . . the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." (emphasis in original). Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). It cannot logically be argued and clearly cannot be proved that the tag of the Reber reference necessarily includes identity data identifying the food item. This is especially true considering the further disclosure in Reber that "[p]referably, the electronic tag 30 is integrated with or attached to at least one of the container 26 and the cover 28." Col. 3, lines 33-35 If the tag 30 is integrated with the container it cannot have identity data identifying a specific food item stored therein since it cannot be known what food may be stored in the container. "The doctrine of inherency is available only when the prior inherent event can be established as a certainty. That an event may result from a given set of circumstances is not sufficient to establish anticipation. Probabilities are not sufficient . . . A prior inherent event cannot be established based upon speculation or where a doubt exists." Ethyl Molded Products Co. v. Betts Package Inc., 9 USPQ2d 1001, 1032-1033 (E.D. Ky. 1988).

The Applicant also submits that the only hand-held device disclosed in the cited section of the Heagle reference is a digital thermometer connected directly to work station (WSM). There is nothing in the cited section that suggests that the identity data should be

read by a hand-held data collector and then transmitted to a computer, as recited in claim 19.

Assuming arguendo that the Reber and Heagle references were combined as suggested in the Office Action, such combination would not produce an apparatus capable of performing the method recited in claim 19. As noted above, neither of the references teach or disclose a hand-held data collector that reads the identity data from a label and that receives data from temperature measuring devices, and then transmits such data to a computer. MPEP § 706.02(j) states "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." See also MPEP §§ 2142 and 2143.

For all of the above reasons, the rejection of claims 19, 22-24, and 26-35 must be withdrawn.

Claims 36-52 were rejected under 35 U.S.C. § 103(a) as being obvious over Reber in view of Heagle and further in view of U.S. 5,711,160 (Namisniak et al.). The Office Action admits that "[n]either Reber et al nor Heagle et al teach automatically determining a shelf life for the food item and the an expiration date as a function of the shelf life" but contends that "Namisniak et al teach creating a list of stored items along with their storage lifetime which determines a first expiration date for the food item as a function of the identity of shelf life at the location and the first date and also an expiration date for each of the food items as a function of the first and second shelf lives and the first and second dates (col. 4, line 66 to col. 5, lines 10)." The Office Action further contended that it would have been obvious "to utilize transmission of information to a CPU, the label printing as taught by Heagle et al into the system of Reber et al because it would provide information to the main terminal as for managers to make decisions on the appropriate time to put or remove food items for sale. And it would have been obvious to one of ordinary skill in the art to utilize the lifetime and expiration date for food items as taught by Namisniak et al into the combined system of Reber et al and Heagle because it would automatically provide the lifetime in memory along with the item name and display both on the item slot."

The Applicant respectfully submits that there is absolutely no basis for the allegation that "Namisniak et al teach creating a list of stored items along with their storage lifetime which determines a first expiration date for the food item as a function of the identity of

shelf life at the location and the first date and also an expiration date for each of the food items as a function of the first and second shelf lives and the first and second dates". Although the Office Action cites Col. 4, line 66, to Col. 5, line 10, in support of this allegation, a review of the cited section clearly reveals that it provides no such disclosure. Specifically, the cited section states:

> The way that the cataloging task creates a list of stored items, along with their storage lifetime and how the association task links the list entry with a particular stored item, has now been explained. The timing task completes the present invention. The timing task tracks and/or displays time information relative to each food item entered into the base unit. There are three possible timing modes: a "count up" mode that increments the number of days the item has been stored, a "count down" mode that decrements the preset lifetime entered by the user, and an "expiration date" mode. The user is able to select the desired mode through a switch or button, depending on the exact implementation. Generally, the entire base unit will operate in only one mode; it would be excessively confusing to use more than one mode simultaneously.

There is nothing in this disclosure regarding moving a food item from one storage location to another. Nor is there anything regarding the impact on the shelf life of a food item caused by moving from one storage location to another. It cannot possibly be alleged that the cited section discloses "identifying a first location of the food item; automatically determining a shelf life for the food item as a function of the identity of the first location; identifying another location to which the food item is moved; and automatically determining and storing a new shelf life for the food item as a function of the first and other locations", as recited in claim 36. Nor can it possibly be alleged that the cited section discloses " (b) determining and storing a first date on which each of the food items is placed at a first location;

> (c) automatically determining and storing (1) a first shelf life for each of the food items as a function of the first location and (2) a first expiration date for each of the food items as a function of the first shelf life and the first date; (d) receiving and storing data identifying a second location to which one of the food items is moved; (e) determining and storing a second date on which the one of the food items is placed at the second location; and (f) automatically determining and storing (1) a second shelf life for the one of the food items as a function of the second location and (2) a new expiration date for the one of the food items as a function of the first and second shelf lives and the first and second dates

as recited in claim 45. A review of the Namisniak reference reveals that the elements of claims 36 and 45 for which it is cited are not disclosed anywhere else in the reference.

With regard to claim 50, the Office Action does not explain where any of the elements of the claim may be taught in any of the cited references. The Applicant respectfully submits that there is a vast difference between monitoring the storage of a particular food item and monitoring and tracking numerous items of food associated with a number of food lots. As noted above, MPEP §§ 706.02(j), 2142 and 2143 all require "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." The Office Action does not show where any of the elements of claim 50 may be found in the prior art. Therefore, such Office Action does not establish a *prima facie* case of obviousness with respect to claim 50.

The various dependent claims add additional features to the independent claims, and are therefore believed to be allowable. Also, the dependent claims are believed patentably distinct on their own merits as being directed to combinations not suggested by the references.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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